

**REMARKS**

In the present Office Action, the Examiner rejected claims 1-59 in view of various references under 35 U.S.C. §§ 102 and 103. Unfortunately, as mentioned above, the Examiner was unable to consider the previously submitted Rule 131 and Rule 132 declarations and associated exhibits, because these documents were lost by the USPTO.

In an Examiner Interview on March 12, 2004, the Examiner indicated that these declarations and associated exhibits were not received and, thus, not considered in the present Office Action. The Examiner advised Applicants to re-submit these declarations and associated exhibits and to respond to the present Office Action to expedite prosecution of the above-referenced application. Given that these declarations and associated exhibits were lost, in the USPTO, the Examiner also indicated that the next office communication will not be a Final Office Action. Accordingly, as advised by the Examiner, the Applicants respond to the present Office Action and re-submit the previously filed declarations and associated exhibits along with a copy of the receipt acknowledgment postcard, bearing the USPTO receipt stamp. Specifically, Applicants re-submit the enclosed Rule 131 declarations of inventors Gary Landrum, Chris Felcman, and David Eichberger and the associated Exhibits A and B pursuant to 37 C.F.R. § 1.131 to swear behind Sikat et al. (US 2001/0031453A1). Applicants also re-submit the enclosed Rule 132 declarations of Gary Landrum, Chris Felcman, and David Eichberger and associated Exhibits 1, 2, and 3 pursuant to 37 C.F.R. § 1.132 as evidence of non-obviousness.

In view of the foregoing evidence and the following remarks, Applicants respectfully submit that the pending claims are patentably distinct from the prior art and in condition for allowance.

**Objections to the Specification**

In the Office Action, the Examiner indicated that the present application lacks the necessary reference to the prior application. Accordingly, the Applicants amended the specification above as suggested by the Examiner.

### **Rejections Under 35 U.S.C. §102**

In the Office Action, the Examiner rejected claims 41-44 under 35 U.S.C. §102(b) as anticipated by Foster et al. (US 5,594,617). Applicants respectfully assert that the pending claims are patentable over the cited reference in view of the following legal precedent and the following remarks.

#### ***Legal Precedent***

First, anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Second, the Examiner must evaluate and consider a functional limitation, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. See M.P.E.P. § 2173.05(g); *In re Swinehart*, 169 U.S.P.Q. 226, 229 (C.C.P.A. 1971); *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997). Indeed, courts have recognized that there may be a practical *necessity* for the use of functional language. See *In re Swinehart*, 169 U.S.P.Q. at 228-29 (emphasis added). Under the view today, functional language in a claim is not objectionable *per se* so long as it avoids problems of undue breadth and vagueness. See Donald S. Chisim, CHISIM ON PATENTS § 8.04, p. 8-99 (citing *In re Swinehart*, 169 U.S.P.Q. at 226). What is important is *not* simply

that a recitation is defined in terms of what it does, but that the recitation has a reasonably well-understood meaning in the art. *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583, 39 U.S.P.Q.2d 1783, 1786 (Fed. Cir. 1996) (further stating that “many devices take their names from the functions they perform . . . [and that] ‘detent’ (or its equivalent ‘detent mechanism’) is just such a term”). In other words, so long as a recitation is readily understood by those in the pertinent art (*i.e.*, it is not vague and unduly broad), it must be given patentable weight.

Third, if the Examiner relies on a theory of inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999) (Emphasis Added). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner, in presenting the inherency argument, bears the evidentiary burden and must adequately satisfy this burden. *See id.* If the Examiner believes the functional limitation to be inherent in the cited reference, then the Examiner “must provide some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Inter. 1986).

Fourth, the drawings of the cited reference must be evaluated for what they *reasonably disclose and suggest* to one of ordinary skill in the art. *In re Aslanian*, 590 F.2d 911, 200 U.S.P.Q. 500 (CCPA 1979). Arguments based on dimensions of the drawing features are of little value where the reference does not disclose specific dimensions or any indication of whether the drawings are to scale. *See Hockerson-Halberstadt, Inc. v. Avia Group Int’l*, 222 F.3d 951, 956, 55 U.S.P.Q.2d 1487, 1491 (Fed. Cir. 2000).

**Deficiencies of Rejection of Claims 41-44 in view of Foster et al.**

***Omitted Features***

Applicants respectfully assert that the cited reference does not disclose all of the recited features of the rejected claims. For example, amended claim 41 recites, *inter alia*, “rotatably coupling the display and keyboard to form a *rack mountable assembly* having a 1U or thinner thickness in a closed configuration.” (Emphasis Added). Applicants respectfully stress that the Foster et al. reference is absolutely devoid of any teaching or suggestion of “1U” or a capability for *rack mounting*. In fact, the *portability or mobility* of Foster et al. is antithetical to the *rack mountability* recited in the instant claim. In view of the omitted features of “1U” and “rack mountable,” *inter alia*, the Foster et al. reference cannot anticipate claim 41.

***Omitted Features are NOT Inherent***

The Examiner argued that the Foster et al. reference discloses, “a structure ... *inherently capable of being mounted* in a 1U thick rack space.” See Office Action, Paper No. 02192004, pages 2-3 (Emphasis Added). Applicants respectfully assert that the cited reference *does not* inherently disclose these features as suggested by the Examiner. Additionally, the Examiner repeatedly asserted that functional language, such as “rack mountable,” is insufficient to distinguish over the prior art. See Office Action, Paper No. 02192004, page 9 (quoting Examiner’s Response to Arguments: “‘rack mountable’ is irrelevant since there is no structure in the claim that is not in the reference.”).

First, Applicants respectfully emphasize that a functional limitation must be given patentable weight in the context in which it is used, as discussed in the legal precedent section above. Thus, the Examiner’s statement that “rack mountable” is *irrelevant* is completely improper. See Office Action, Paper No. 02192004, page 9. Moreover, the Examiner’s statement that the functional limitations “have been given no patentable weight” is also improper. See Office Action, Paper No. 02192004, page 10. One of ordinary skill in the art

of computers would clearly understand the claim recitation “a structure ... *inherently capable of being mounted* in a 1U thick rack space” to define the scope and boundaries of the instant claims. Thus, the Applicants stress that the Examiner cannot simply dismiss this claim recitation as irrelevant or of no patentable weight.

Second, a position of inherency cannot be based on unsupported possibilities of what the disclosed notebook computer 10 of Foster et al. *hypothetically could* do. In the Office Action, the Examiner stated: “if a book shelf unit were called a rack and then the structure of Foster et al. ‘671 were placed on one of those shelves, the structure would then be a “rack mountable assembly.” See Office Action, Paper No. 02192004, page 3. However, the Examiner has completely ignored the context of the rack mountable assembly of claim 41. Specifically, the claim recites 3/4U and 1U dimensions, which clearly correspond to a computer rack (not a book shelf). Moreover, the Microsoft Computer Dictionary defines rack-mounted as: “built for installation in a metal frame or cabinet of standard width (typically 19 inches or 23 inches) and mounting arrangements.” MICROSOFT COMPUTER DICTIONARY 435 (Fifth Ed. 2002). Thus, one of ordinary skill in the art would not confuse a notebook computer 10 hypothetically resting on a book shelf with a “rack mountable assembly having a 1U or thinner thickness,” as set forth in claim 41. If the Examiner believes the “rack mountable assembly” to be inherent in the cited reference, then the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Thus, the Examiner’s position that the notebook computer 10 is *hypothetically capable* of forming a rack mount assembly is legally insufficient, because rack mountability in a 1U or thinner thickness *does not necessarily flow* from the teachings of Foster et al.

In view of these deficiencies, Applicants respectfully assert that independent claim 41 and its respective dependent claims 42-44 are patentable over the cited reference. For these reason, Applicants respectfully request allowance of the foregoing claims.

**Deficiencies of Rejection of Claims 56-57 in view of Sikat et al.**

In the Office Action, the Examiner also rejected claims 56-57 under 35 U.S.C. §102(e) as being anticipated by Sikat et al. (US Patent Application 2001/0031453). Applicants respectfully traverse this rejection.

***Removal of Sikat et al. and Mammoser et al. Pursuant to 37 C.F.R. § 1.131***

In view of the earlier date of the invention of the subject matter disclosed and claimed in the present application, Applicants have chosen to remove Sikat et al. (US 2001/0031453 A1) and Mammoser et al. (U.S. Patent No. 6,442,030) pursuant to 37 C.F.R. § 1.131. Applicants note that the Mammoser et al. reference was previously disclosed in an Information Disclosure Statement and PTO-1449. Under Rule 131, the Applicants may overcome a prior art rejection by filing an appropriate declaration that establishes invention of the claimed subject matter by the Applicants prior to the effective date of the reference(s) relied upon in the rejection. Prior invention may be shown either by proving actual reduction to practice prior to the effective date of the reference(s) or by proving conception of the invention prior to the effective date of the reference(s) coupled with reasonable diligence from prior to the effective date of the reference(s) to the filing date of the application.

Accordingly, Applicants submit the enclosed Rule 131 Declarations of inventors Gary Landrum, Chris Felcman, and David Eichberger pursuant to Rule 131, signed by the inventors of record, to demonstrate that the invention disclosed and claimed in the present application was conceived and actually reduced to practice prior to the effective date of Sikat et al. and, also, prior to the effective date of Mammoser et al. Specifically, in paragraph 3 of the attached Rule 131 Declarations, the applicants/inventors declare that the subject matter disclosed and claimed in the above-referenced application was conceived at least as early as August 19, 1999. Applicants further submit that Exhibit A in its entirety, along with the corresponding Rule 131 Declarations, is sufficient to demonstrate conception of the claimed subject matter at least as early as August 19, 1999.

The effective date of Sikat et al. is December 18, 2000, while the effective date of Mammoser et al. is April 26, 2001. As indicated by paragraph 4 of the attached Rule 131 Declarations, the applicant/inventors declare that the invention disclosed and claimed in the present application was actually reduced to practice no later than August 28, 2000. Applicants further submit that Exhibit B in its entirety, along with the corresponding Rule 131 Declarations, is sufficient to demonstrate actual reduction to practice of the claimed subject matter no later than August 28, 2000.

In view of the evidence discussed above, Applicants respectfully request the Examiner remove Sikat et al. from consideration and allow pending claims 56-57.

### **Rejections Under 35 U.S.C. § 103**

In the Office Action, the Examiner presented a multitude of references in various permutations and combinations to reject the instant claims. Under 35 U.S.C. §103(a), the Examiner rejected claims 1-5, 8-14, 15-21, 33-37, 47 and 50 as unpatentable over Harwell (U.S. Patent No. 6,142,590) in view of Foster et al.; claims 7, 51, 52, 22, 53, 38-40, 48 and 49 as unpatentable over Harwell in view of Foster et al. and in further view of Sikat et al.; claims 23-26, 28-32, and 58 as unpatentable over Harwell in view of Baddour et al. (U.S. Patent No. 6,685,033) and Foster et al.; claims 27, 54, 55 and 59 as unpatentable over Harwell in view of Foster et al., Baddour et al., and Sikat et al.; claim 45 as unpatentable over Foster et al. in view of Sikat et al.; and claim 46 as unpatentable over Foster et al. in view of Harwell. Applicants respectfully traverse these rejections for a number of reasons.

### ***Legal Precedent***

First, the burden of establishing a prima facie case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render

the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been “well within the ordinary skill of the art” based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Second, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Third, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the

teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); see M.P.E.P. § 2143.01.

Fourth, in order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 U.S.P.Q. 340 (CCPA 1958); *see also* M.P.E.P. § 2144.06.

***Removal of Sikat et al. Pursuant to 37 C.F.R. § 1.131***

Again, as discussed above, Applicants have chosen to remove Sikat et al. and Mammoser et al. pursuant to 37 C.F.R. § 1.131 in view of the earlier date of the conception and actual reduction to practice of the subject matter disclosed and claimed in the present application. Accordingly, all rejections based on Sikat et al. (or potential rejections based on Mammoser et al.) must be withdrawn.

**Harwell-Foster et al. Reference Combination**

After removing the Sikat et al. reference, the only remaining rejections under Section 103 pertain to the Harwell-Foster et al. combination with or without Baddour et al. In the Office Action, the Examiner rejected claims 1-5, 8-14, 15-21, 33-37, 47 and 50 under 35 U.S.C. §103(a) as unpatentable over Harwell (US 6,142,590) in view of Foster et al., and claim 46 as unpatentable over Foster et al. in view of Harwell. The Examiner also rejected claims 27, 54, 55, and 59 over Harwell in view of Foster et al. and Baddour et al.

The cited reference combinations fail to render obvious the instant claims for at least three reasons. First, the cited reference combination fails to disclose all of the features recited in the instant claims. Second, the cited reference combination lacks the necessary suggestion or motivation to combine. Third, the Applicants submit evidence of non-obviousness with regard to the subject matter disclosed and claimed in the present application.

***Omitted Features***

In a general sense, each of the claims rejected under the instant Foster et al.-Harwell reference combination or the Harwell-Foster et al.-Baddour et al. reference combination recite some semblance of a user interaction assembly mountable in a 1U thick rack space. As discussed in detail above, Applicants reiterate that, during patent examination, the pending claims must be given a reasonable interpretation consistent with the specification. See M.P.E.P. §§ 608.01(o) and 2111. Interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. See M.P.E.P. § 2111. Regarding the recitation of “1U,” a “rack,” “rack mountable,” and other correlations to a rack structure, the Examiner must interpret the claims in a reasonable manner.

Turning to the claims, the independent claims 1, 15, 33, and 47 rejected under this reference combination recite the following features:

Claim 1: “a user interaction assembly mountable in a 1U thick rack space of the rack mount.”

Claim 15: “a user interaction assembly having a clamshell configuration mountable in a 1U rack space.”

Claim 33: “disposing a keyboard and display in a 1U rack space.”

Claim 47: “slidably removing a keyboard and display from a 1U thick rack space.”

The Examiner concedes that the Harwell reference merely discloses a 2U thick rack space and a user interaction device rested therein. See Office Action, Paper No. 02192004, page 4. As such, the Examiner concedes the Harwell reference fails to disclose any semblance of a 1U thick user interaction device or a device capable of being configured for a 1U thick rack space. See *id.* The Examiner attempts to satisfy this deficiency with the Foster et al. reference.

First, Applicants respectfully assert that the Examiner has attributed qualities to the Foster et al. reference that are not disclosed therein. Specifically, the Examiner contends that the notebook computer of Foster et al. is “*inherently capable* of being mounted in a 1U thick rack space.” See Office Action, Paper No. 02192004, pages 2-3. In sharp contrast to the instant claims, the Foster et al reference discloses a *notebook or portable* computer. As is commonly known, the primary purpose of a notebook computer is to allow for *mobile* computing and ease in transportation during such computing. This is antithetical to the user interaction systems configured for *rack mounting* as recited in the instant claims. For the reasons discussed in detail above, there is no reason to believe the notebook computer of the Foster et al. reference is “capable of being mounted in a 1U thick rack space,” as the Examiner contends. The ability to rest the notebook computer 10 of Foster et al. onto a book shelf does not support the Examiner’s hypothetical of rack-mounting the notebook computer 10. See Office Action, Paper No. 02192004, page 3. The claim recitations of “U” clearly correspond to rack-mounting in standard racks in the computer industry, as recognized by one of ordinary skill in the art. The mere fact that the art of the Foster et al. reference *may* be mounted as the Examiner contends is not sufficient evidence to support the conclusion that the Foster et al. notebook *inherently or necessarily* is mountable in a rack, much less a 1U rack space. For these reasons, the Foster et al. reference does not obviate the deficiencies of the Harwell reference.

Second, the Examiner contends that, the recitation “mountable in a 1U thick rack space” is merely functional. See Office Action, Paper No. 02192004, page 8. As discussed in detail above, the Applicants respectfully stress that the functional-structural recitation, “mountable in a 1U thick rack space” must be evaluated and given patentable weight in the context in which it is used. In the instant claim, the recitation serves to define structural attributes of interrelated component parts of the claimed assembly in a clear and complete manner. Specifically, the foregoing recitations clearly define the structure of the claimed system based on 1U and rack mounting. As argued above, the mere fact that the laptop of Foster et al. *may*, in a given orientation, have a thickness less than 1U is not sufficient

evidence to assume that the laptop is, in fact, mountable in a rack. For example, the Foster et al. reference discloses a laptop which, in its thinnest position, prevents access to the peripheral connectors 42. *See* Foster et al., column 4, lines 30-36. In this thin position, the moveable battery blocks access to the connectors. *See id.* Although the prior art *may hypothetically* “fit” inside of a 1U space in a rack, such lack of access suggests that the prior art is not capable of being *mounted* in the same 1U sized rack. In other words, it does not *necessarily flow* that the notebook computer 10 would or could mount within a 1U space of a rack. By interpreting the cited reference as the Examiner contends, the Examiner has failed to give the proper patentable weight to the 1U rack mountable feature of the instant claims. Accordingly, the Examiner’s argument that the above recitation is, “merely functional,” is an insufficient reason to dismiss the limitation. *See id.*

Finally, the Baddour et al. reference does not obviate the deficiencies of the Harwell and Foster et al. references. In fact, the Baddour et al. reference discloses only a rack mounted computing device, which is devoid of any sort of display as recited in the instant claims. *See* Baddour et al., Fig. 6; Abstract.

For these reasons, Applicants respectfully assert that independent claims 1, 15, 23, and 47 and their respective dependent claims are patentable over the cited reference combination. Accordingly, Applicants respectfully request allowance of the pending claims.

***Lack of Motivation or Suggestion to Combine***

In addition, the Examiner has not shown the requisite motivation or suggestion to modify or combine the Harwell, Foster et al., and Baddour et al. references to reach the presently claimed technique. The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990).

In the rejection, the Examiner combined the Harwell and Foster et al. references based on the *conclusory and subjective statement* that it would have been obvious to combine rack system of Harwell with the less than 1U thick computer of Foster et al. “for *increased storage capabilities* due to the decreased thickness and ease in assembly, since the less than 1U thick computer would fit in a 1U thick space.” See Office Action, Paper No. 02192004, page 5. However, the Examiner has not provided any objective evidence to support this alleged reason to combine the cited references. As argued above, the Foster et al. reference relates to *portable* notebook computers, which are primarily concerned with *ease of transportation*. In contrast, rack systems are highly concerned with storage capabilities, redundancies, security, and so forth. At least in terms of storage capabilities, if not more, a portable computer is clearly not suitable for the requirements of rack systems. Accordingly, Applicants challenge the Examiner to produce *objective evidence* of the requisite motivation or suggestion to combine the cited references.

Applicants further emphasize that it is improper to use hindsight reconstruction in formulating a rejection under Section 103. See *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I 1985); see also *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)). Avoiding hindsight reconstruction is especially important regarding less technologically complex inventions, where the very ease with which the invention can be understood may prompt one employ such hindsight. See *id.* Applicants respectfully assert the Examiner, at best, employed the teachings of the instant application to establish the motivation necessary to combine the foregoing references. As such, Applicants respectfully assert the Examiner has employed impermissible hindsight reconstruction.

In view of the missing objective evidence of the necessary motivation or suggestion to combine the references, independent claims 1, 15, 23, and 47 and their respective dependent claims are believed to be patentable over the cited reference combination. Accordingly, Applicants respectfully request allowance of the pending claims.

***Evidence of Non-Obviousness Pursuant to 37 C.F.R. § 1.132***

Applicants further submit evidence of non-obviousness pursuant to 37 C.F.R. § 1.132. Specifically, as discussed in further detail below, the Applicants submit Rule 132 Declarations of inventors Gary Landrum, Chris Felcman, and David Eichberger and objective evidence of commercial success to rebut the Examiner's previous rejections under Section 103.

Obviousness is a conclusion of law based on a number of underlying factual inquiries. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1572 (Fed. Cir. 1988). The Supreme Court has stated that three factual determinations are required in an analysis under Section 103: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). In addition, the Examiner must consider all secondary considerations bearing on obviousness, such as commercial success, "industry acquiescence," long felt but unsolved needs, and failure of others, must also be considered. *Id.* at 17-18; *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983); *see also* M.P.E.P. § 716.01(a). Moreover, the Examiner must consider all of the competent rebuttal evidence taken as a whole, including arguments and secondary considerations, against evidence of a *prima facie* case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984); *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992); *see also* M.P.E.P. § 716.01(d). Regarding the secondary considerations of non-obviousness, a "nexus" is required between the merits of the claimed invention and the evidence of secondary considerations. *See Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 305 (Fed. Cir. 1985); *see also* M.P.E.P. § 716.01(b). In addition, to be of probative value, the secondary considerations must be factually supported by an appropriate affidavit or declaration and objective evidence. *See In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); *In re Lindner*, 457 F.2d 506, 508 (C.C.P.A. 1972); *see also* M.P.E.P. § 716.01(c). Regarding evidence of commercial success, commercial success abroad, as well as in the United States, is relevant in resolving the issue

of non-obviousness. *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984); *see also* M.P.E.P. § 716.03.

In view of the commercial success of the subject matter disclosed and claimed in the present application, Applicants have chosen to rebut the Examiner's obviousness rejections based on evidence of non-obviousness pursuant to 37 C.F.R. § 1.132. Accordingly, Applicants submit the enclosed Rule 132 Declarations of inventors Gary Landrum, Chris Feleman, and David Eichberger, signed and dated by the inventors of record, to demonstrate that the invention disclosed and claimed in the present application has achieved significant commercial success attributed to the features set forth in the pending claims.

Specifically, in paragraphs 3 and 4 of the attached Rule 132 Declarations, the applicants/inventors declare to have been involved in the development of a product named Ruger, which comprises a 1U rack mountable display and input device, e.g., a trackball and/or keyboard, as set forth in the claims and as illustrated in Exhibit 1. In paragraph 5 of the attached Rule 132 Declarations, the applicant/inventors further declare that the Ruger product has a clamshell configuration in which the display can be nested within the input device, e.g., the keyboard, as set forth in the claims and as illustrated in Exhibit 1. For these reasons, the Ruger product is commensurate in scope with the pending claims of the present application.

Turning to the sales data set forth in Exhibit 2, the applicants/inventors further declare, upon information and belief, that the Ruger product has been sold from the third fiscal quarter of 2001 through the present time. *See* Rule 132 Declarations, Paragraph 6. Furthermore, the applicants/inventors declare, upon information and belief, the sales of the Ruger product in the United States were tabulated for the third fiscal quarter of 2001 through the third fiscal quarter of 2003. *See* Rule 132 Declarations, Paragraph 7; Exhibit 2. Regarding sales numbers, the applicants/inventors declare, upon information and belief, the quarterly sales of the Ruger product during the foregoing time period were as follows: 711, 2830, 2241, 2835, 4089, 4125, 3836, 4280, and 4327, as tabulated in exhibit 2. *See* Rule 132 Declarations, Paragraph 8; Exhibit 2 (highlighted in yellow). Upon information and belief, the applicant/inventors further

declare that the Ruger product achieved a significant sales growth relative to all rack mountable keyboards, all rack mountable monitors, and all rack mountable keyboards and monitors of the Assignee. *See* Rule 132 Declarations, Paragraphs 9-11; Exhibit 2 (highlighted in orange, blue, and green). For example, relative to all rack mountable keyboards and monitors of the Assignee, the relative sales growth of the Ruger product increased from 5.1% to 53.7% between the third quarter of 2001 and the third quarter of 2003. *See* Rule 132 Declarations, Paragraph 11; Exhibit 2 (highlighted in green). For these reasons, Applicants believe the disclosed and claimed subject matter set forth in the present application has attained *significant commercial success* in the art of rack systems and, particularly, in the art of rack mount keyboards and monitors.

Turning to the *nexus* criteria, the Applicants submit evidence of customer feedback, which clearly indicates the foregoing commercial success is attributed to the disclosed and claimed features of the present application. Specifically, the applicants/inventors declare, upon information and belief, the Assignee provided the Ruger product to at least thirteen representative customers and tabulated the customer feedback in a spreadsheet set forth in Exhibit 3. *See* Rule 132 Declarations, Paragraphs 12 and 13; Exhibit 3. Regarding previous rack mount keyboards and displays, the applicants/inventors declare, upon information belief, the customers commented on a general dissatisfaction with the size of previous 2U configurations and, specifically, commented on the importance of size "to save rack space" and that "every 'U' is precious." *See* Rule 132 Declarations, Paragraph 14; Exhibit 3 (highlighted in yellow). Moreover, the applicants/inventors declare, upon information belief, the customers indicated an unsatisfied need for a 1U assembly. *See* Rule 132 Declarations, Paragraph 15; Exhibit 3 (highlighted in yellow). One customer specifically commented "from the beginning we were looking for 1U integrated keyboard from sizing point of view." *Id.* Finally, the applicants/inventors declare, upon information belief, the customers indicated appreciation and praise of the Ruger product with reference to the Ruger's 1U size, space savings relative to existing 2U monitor and 1U keyboard/switch, form factor, and ability of the display screen to fold down rather than up (i.e., clamshell configuration). *See* Rule 132 Declarations, Paragraph 16; Exhibit 3 (highlighted in yellow). Clearly, this customer feedback indicates the importance

placed on every "U" of rack space, the dissatisfaction with previous 2U configurations, and the excitement about the 1U and clamshell features of the Ruger product. *See* Rule 132 Declarations, Paragraphs 14-16; Exhibit 3 (highlighted in yellow). For these reasons, Applicants attribute the foregoing commercial success to the disclosed and claimed subject matter set forth in the present application. Therefore, the foregoing *commercial success has a strong nexus with the claimed invention.*

Turning to the cited references, Harwell teaches a rack mountable keyboard and monitor disposed end-to-end in a 2U rack space. *See* Harwell, Col. 2, lines 51-67. The Examiner turned to Foster et al. for its smaller dimensions, yet Foster et al. teach a *non-rack mount* laptop computer with no mention of 1U or any sort of rack mounting. *See* Foster et al., Col. 3, lines 18-29. Finally, the Baddour et al. reference teach a rack mounted computer device without any display. *See* Baddour et al., Abstract, Fig. 6. In contrast, the present claims recite a display and input device mountable in a 1U rack space and, in certain claims, a clamshell configuration of the display and input device. As discussed above, the Applicants have attained *significant commercial success attributed to these claimed features*, which are not disclosed by Harwell, Foster et al., or Baddour et al. Apparently, the Examiner believes that a laptop computer is an obvious solution to the space problems associated with rack systems, yet the foregoing commercial success and customer feedback clearly indicate the contrary.

For these reasons, Applicants reiterate that the present claims are patentably distinct from the cited references, taken alone or in combination. Accordingly, Applicants request the Examiner withdraw all previous rejections and allow the pending claims.

**Conclusion**

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Date: May 14, 2004

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Tait R. Swanson", written over a horizontal line.

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